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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,080	11/27/2001	David J. Steklenski	83756D-W	9561
7590	12/19/2003		EXAMINER	
Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			SIEFKE, SAMUEL P	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,080

Applicant(s)

STEKLENSKI, DAVID J.

Examiner

Samuel P Siefke

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 25-30 is/are rejected.
- 7) ☒ Claim(s) 20-24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-3, 11, 12, 28** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1,8,12,14,15** of copending Application No. **09/995,081**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both contain a substrate on which an alanine and a binder are coated on, then exposed to radiation, which produces radicals that remain stable for long periods of time. The both describe the crystalline alanine comprises particles less than 100 microns in size.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim **29** and **30** recites the limitation "the solvent" in line 1 of each of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 does not disclose of a solvent to be used.

Claim Objections

Claim **20** is objected to because of the following informalities: Claim 20 is dependent upon claim 1. Examiner suggests that it be changed to be dependent upon claim 19 to avoid 112 antecedent basis rejection. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1, 2, 3, 4, 5, 9, 10 17, 18, 19, 27,28** are rejected under 35

U.S.C. 102(b) as being anticipated by DE 19637471.

'471 teaches a radiation dosage element that comprises: a support (polyethylene or polyester) being flexible upon which a coated layer that comprises alanine and a binder (polystyrol); when exposed to radiation produce radicals. The mixture may also contain a plasticiser. The mass ration of alanine to the binder is 2:1. The dosimeter is designed to adhere to the carrier.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **14** and **16** are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19637471 in view of Hanisch et al. (USPN 5,066,863).

'471 teaches a radiation dosage element as disclosed above.

'471 does not teach other binders that can be used, specifically polyurethane.

Hanish teaches suitable binders for alanine that comprise polyurethane or other materials of this nature (acrylates) because of its strength properties (col. 3, lines 53-68). It would have been obvious to one having an ordinary skill in the art to modify '471 to include polyurethane as a binder because it gives advantageous mechanical strength properties to the coating.

Claims **6-8, 11, 12, 25-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19637471 in view of T. Kojima et al., "Alanine Dosimeters Using Polymers as Binders", Applied Radiation & Isotopes, Vol. 37, No. 6, (1986), Pergamon Journals Ltd., pp. 517-520.

'471 teaches a radiation dosage element as disclosed above.

'471 does not teach alanine in a crystalline form where the particles are less than 100 microns in size and the thickness of the coating layer or the support.

Kojima teaches an alanine dosimeter using polymers as binders. Kojima teaches that the alanine is supplied ordinarily in the form of very small grain crystalline powder, the size of the grain varies from a few to several hundred micrometers (introduction). Therefore it would have been obvious to one having an ordinary skill in the art to modify '471 to use alanine in a crystalline form having a grain size of less than 100 microns because this is the normal form it comes in and readily available for use. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the

thickness of the coating layer, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims **13**, **15**, **19** are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19637471 in view of Morita et al. (USPN 4,668,714).

'471 teaches a radiation dosage element as disclosed above.

'471 does not teach other binders that can be used, specifically polyurethane, other additives can be incorporated into the coated layer.

Morita teaches suitable binders for alanine that comprise using synthetic rubbers (ethylene vinyl acetate) because it does not produce free radicals upon irradiation with radiation. It would have been obvious to one having an ordinary skill in the art to modify '471 to include ethylene vinyl acetate as a binder because it does not produce free radicals when exposed to radiation.

Claims **29** and **30** are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19637471 in view of JP 401080895.

'471 teaches a radiation dosage element as disclosed above.

'471 does not teach a solvent for dissolving alanine

JP 895 teaches a method of making a dosimeter. The method comprises using an organic solvent such as methanol to crystalize alanine for depositing of alanine on a surface. It would have been obvious to modify '471 to include an organic solvent to crystalize alanine in order to form a solid layer such as a dosimeter.

Allowable Subject Matter

Claims 20-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach or fairly suggest the use of silica or alumina used in a dosimeter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P Siefke whose telephone number is 703-306-0093. The examiner can normally be reached on M-F 7:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Sam P. Siefke



December 11, 2003


Jill Warden
Supervisory Patent Examiner
Technology Center 1700